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EXAMINER

CHEN, TE Y

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/960,548 | <b>Applicant(s)</b><br>IGAKURA, TOMOHIRO |  |
|                              | <b>Examiner</b><br>SUSAN Y. CHEN     | <b>Art Unit</b><br>2161                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/17/2006</u>  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

This office action is in respond to the appeal decision made by the petition office as dated on 03/23/2010.

Claims 1-17 are pending for examination.

***Telephone Interview***

Telephone interviews have been conducted between Applicant's representatives (Richard LaCava & Andrew Phillips) on 10/27/2009 & 11/18/2009 and the examiner (Susan Chen). During the interviews applicant's representatives requested to withdraw the notice of abandonment filed on 10/23/2009 and argued that the Appeal Brief filed on 04/06/2009 has addressed the issues in the notice of non-compliant appeal Brief dated on 03/06/2009. The examiner indicated that the mapping of the claimed subject matters as recited in claims 1 and 7 are still non-compliant because the ambiguous nature of the claimed subject matters. However, per applicant's representatives' request, the examiner indicated that she will withdraw the notice of abandonment dated on 10/23/2009 and give the applicant one more chance to amend the claims to reflect the novelties of instant application.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

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*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) (“The term process’ means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”).

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase “anything under the sun that is made by man” is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *In re Warmerdam*, 33 F.3d at 1354, 31 USPQ2d at 1754 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a new and useful invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. While this is easily stated, determining whether an applicant is seeking to patent an abstract idea, a law of nature or a natural phenomenon has proven to be challenging. These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) (“idea of itself is not patentable, but a new device by which it may be made practically useful is”); *Mackay Radio & Telegraph Co. v. Radio Corp. of America*, 306 U.S. 86, 94, 40 USPQ 199, 202 (1939) (“While a scientific truth, or the mathematical expression of it, is not patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”); *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759 (“steps of locating’ a medial axis, and creating’ a bubble hierarchy . . . describe nothing more than the manipulation of basic mathematical constructs, the paradigmatic abstract idea”).

The courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena. The concern over preemption was expressed as early as 1852. See *Le Roy v. Tatham*, 55 U.S. 156, 75 (1852) (“A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.”); *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 132, 76 USPQ 280, 282 (1948) (combination of six species of bacteria held to be nonstatutory subject matter).

Accordingly, one may not patent every “substantial practical application” of an idea, law of nature or natural phenomena because such a patent would “in practical effect be a patent on the [idea, law of nature or natural phenomena] itself.” *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

Claims 1 and 7, are rejected under 35 U.S.C. 101, because the claimed subject matter is directed to non-statutory subject matter.

As to claim 1, applicant seemed try to recite a utility to manage files at the preamble of the claim, however, the body of the claim lacks of any physical device or

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machine to really execute the claimed functional steps which renders the claimed system as a software per se.

As to claim 7, the claimed method not only lacks any physical device or computer device to perform the claimed managing files function, but also failed to transform the claimed subject matters into a specific state of article. Thereby, this claim merely direct to non-statutory which failed to fall into anyone of the four categories - process, machine, manufacture, or composition of matter as specified under 35 U.S.C. 101. In re Bilski.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, applicant recited the claims as following:

“A file managing system for managing files comprising: a manager for managing a plurality of files having the same file title but different contents as separate files, and for managing a plurality of files having the same content but different titles as a single file.”

For the claim set forth above, it is first noted by the examiner that applicant failed to define the metes and bounds of the claimed contents and the links of the claimed content, titles, single file and the plurality of files. Further, It seems that applicant try to map the claimed subject matters by referencing to P. 1, lines 6 -13, P. 15, lines 15-25, P. 16, lines 19-25 and P. 30, lines 26-27 of instant specification (see P. 4, Appeal Brief filed on 04/06/2009), however, the important links between the claimed "a manager" and these specified excerpts are either missing or unclear, as such, it renders the claimed file manager and its associated functional steps as indefinite.

Regarding Claims 7, applicant recited the claims as following: “A file managing method for managing files, wherein a plurality of files having the same file title but different contents are managed as separate files, while also managing a plurality of files having the same content but different titles as a single file.”

Again, applicant seemed try to map the claimed subject matters by referencing to P. P. 1, lines 6 -13, P. 15, lines 15-25, P. 16, lines 19-25 and P. 30, lines 26-27 of instant specification (see section D of P. 11-12, Appeal Brief filed on 04/06/2009), however, the important links of the claimed subject matters such as “managing a plurality of files having the same content but different titles as a single file” and the specified excerpts are unknown. In addition, the claim language use the term “wherein” but the instant specification fails to provide actual steps to perform or limit these claims

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to a particular structure, thus, this term renders the claimed scope to be indistinct. See *In re Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005).

Due to the ambiguous nature of instant invention, the following art rejection is as to the best of the examiner ascertain. Further, the claims and only the claims form the metes and bounds of the invention. "Office personnel are to give claims their broadest reasonable interpretations in light of the supporting disclosure, *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claims are not read into the claims. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" MPEP p 2100-8, c2, I 45-48; p 2100-9, c1, I 1-4). The examiner has full latitude to interpret each claim in the broadest reasonable sense. The examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7 and 12, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,560,631 issued to Ishihara et al. (hereinafter referred as Ishihara).

As to claims 1 and 7, Ishihara discloses a file management system with means and method to manage files comprising:

managing a plurality of files having the same file title but different contents as separate files [e.g., the data files in a conventional file management system when they are shared by a plurality of computer can be managed to have the same file name and path name (or titles) but completely different contents in reference to Fig. 5 and col. 6, lines 21-26]; and

managing a plurality of files have the same content but different titles as a single file [e.g., the use of file process execution controller (e.g., unit 174, Fig 1 and associated text) which makes the cached copies of remote data and program files (e.g., col. 7, lines 6-25) per executes a single file analytical procedure to create a work area has the same shared file content but different file titles via different linking to a unique file naming conversion format (e.g., the intermediary data files have naming format specified at col. 6, lines 58 - 62), wherein the file analytical procedure itself is a single file in a naming convention format at col. 6, lines 55-57].



As to claims 2 – 3 and 12, Ishihara discloses a file management system [e.g. col. 2, lines 15 –36] with means and method to perform the following steps as claimed by applicant:

a) a GUI interface [e.g., the GUI interface of each terminal station at col. 9, lines 39-42] coupled to the data processor [e.g., the Process Execution Unit 3, Fig. 1] and system users, wherein, the GUI interface in response to the user's request / input will register or retrieve registered files [e.g., col. 12, lines 1-7, Fig. 8, col. 11, lines 54-61; Fig. 15 and associated text];

b) a memory unit including a correspondence table [e.g., the tables: 172aa, Fig. 9, 172ab, Fig. 10, 172ac of Fig. 11 and 173a, Fig. 12], in which correspondence relationships of file titles, file ID and managing IDs are recorded [e.g., col. 9, lines 55 – col. 10, line 32]; and a file memory [e.g., the Cache management table 173a, Fig. 12], in which managing IDs and files are recorded [col. 10, lines 42-49];

c) a data processor [e.g., the process execution unit 3, Fig. 1, the multiprocessors, col. 5, lines 9-14] including:

means for producing a new managing ID [e.g., see the three-level standard data creating processes, Fig. 4] and registering, in the file memory, the new managing ID and a file to be registered [e.g., Fig.(s) 4-6 and associated texts, col. 12, lines 1 – 16];

means for deleting the managing ID and the registered file from the file storage for duplicated files [col. 2, lines 8-10, col. 4, lines 3-22, S41-S43, Fig. 19; col. 14, lines 39-46];

means for retrieving the file memory with managing IDs to get corresponding files [e.g., col. 2, lines 29-36, Fig. 20 and associated texts];

means for sending the obtained files to a file output unit [e.g., the CORBA architecture, col. 11, lines 54-57];

means for comparing a file content to be registered with the registered file in the memory [e.g., col. 13, lines 12-16];

means for registering the file ID, file title and new managing IDs [e.g., the step S1, Fig. 15];

means for updating a correspondence table, if a same content file has been registered in the memory [e.g., col. 12, lines 1-16; col. 13, lines 19-28];

means for retrieving a corresponding table [e.g., the created link of 172a, 173a, S32, Fig. 18; col. 14, lines 47-55];

d) the file output unit sending out, to the file request input unit, the file corresponding to the requested file title and ID from the input unit as delivered from the data processor [e.g., col. 10, lines 33 – 41].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6, 8-11 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,560,631 issued to Ishihara et al. (hereinafter referred as Ishihara), in view of U.S. Patent No. 5,109,511 issued to Nitta et al. (hereinafter referred as Nitta).

As to claims 4 and 13, Ishihara discloses all the features as recited in claims 2 and 3, except he fails to specifically teach the memory unit including hash tables in which relationships of hash value of files and managing IDs are recorded, such that the processor can use the hash table to retrieve, register and verify the contents of the associated files as claimed by applicant.

However, Nitta discloses a memory unit including hash tables as claimed by applicant for a multi-task processor [col. 3, line 40-45] to manipulating the associated data elements in file system as claimed by applicant [e.g., Abstract, the unit 20, Fig. 1; Fig.(s) 4-12 and associated texts].

Therefore, with the teachings of Ishihara and Nitta in front of him/her, an ordinary skilled artisan at the time the invention was made would be motivated to modify the file management system Ishihara with the hash tables as taught by Nitta, because by doing so, the combined system processor will be able to management of data suitable for high-speed access to a large quantity of files without lock operation under the multiprocessor environment or the multi-task processing environment [e.g., Nitta:

Abstract, lines 14-18]. Furthermore, the use of counter data hold in the hash tables for confirming that during the processing of registration of a certain data element by a certain process the processing of registration of another data element having the same home position as the certain data element is not performed in parallel by another process. The provision of the registration counter makes it possible to prevent double registration of the same data element into the hash table. Also, since one registration counter is provided not for the whole of the hash table but for each table entry, the probability of occurrence of collision in access to the registration counter can be reduced [Nitta: col. 2, lines 16 – 42].

As to claims 5 and 14, the combined system discloses all the features as claimed in claims 4 and 13, it further discloses that the hash tables are each provided for each file title, and the hash table retrieving means decides, if no same title file as the file title of the any retrieved file has been registered in the file memory, that no hash table retrieval result is present, and retrieves, if a same title file has been registered in the file memory, the hash table corresponding to the file title of the same title file with the hash value of the pertinent file to be registered used as a key value [e.g., Nitta: Fig. 12 and associated text].

As to claim 6 and 15, the combined system discloses all the features as claimed in claims 4 and 13, the combined system further discloses that only a single hash table is provided for all file titles [e.g., the hash table 30, Fig. 1].

As to claims 8-11 and 9-16, these claims recited the same subject matters as claims 2-6 and 13-15 in form of method, since the features of these claims have been disclosed or suggested by the combined system as discussed above, hence these claims are rejected for the same reason.

### ***Response to Arguments***

Applicant's arguments filed on 04/06/2009 have been fully considered but they are not persuasive.

The examiner disagrees with applicant's piece-meal interpretations/arguments against the prior art on record. Specifically applicant argued that Ishihara failed to disclose/teach "a manager for managing a plurality of files having the same content but different titles as a single file" as recited in claim 1.

In response to applicant's arguments, it is first noted that applicant failed to define the metes and bounds of the claimed contents and the links of the claimed content, titles, single file and the plurality of files, thereby they are widely open for prior art interpretations.

Further, Ishihara has clearly disclosed the claimed limitations recited in claim 1 as address above, for example, Ishihara clearly disclosed that his invention comprises a file process execution controller ( or manager, the unit 174, Fig 1 and associated text) which makes the cached copies of remote source data and program files per executes a

single file analytical procedure to create a work area (e.g., col. 7, lines 6-25, Fig. 15 and associated texts) per a Graphic User Interface controller (e.g., unit 171, Fig. 8 and associated texts). The work area links the same source file content but different file titles according to a unique file naming conversion schema (e.g., the intermediary data files have naming format specified at col. 6, lines 58 - 62), wherein the file analytical procedure itself is a single file and in a naming convention format at col. 6, lines 55-57. Thus, in contrary to applicant's arguments, Ishihara has clearly disclosed the claimed limitations as recited in claim 1.

For the rest of arguments, which either contains more details than claims or has been addressed above, hence, the examiner maintains the same rejections on record.

Based on the above discussion above, since applicant does not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The examiner concludes that the prior art read on the claimed features.

### ***Conclusion***

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g., the 35 U.S.C. 112 or 101 defects) set forth by the Examiner prior to the office action, that

applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1) U.S. Patent No. 5,734,886 issued to Grosse et al. which disclosed database dependency resolution method and system for identifying related data files.

2) US Patent No. 6,353,820 issued to Edwards et al. which disclosed a method and system for using dynamically generated code to perform index record retrieval in certain circumstances in a relational database manager.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Susan Y Chen/  
Primary Examiner  
Art Unit 2161

January 17, 2011